

REMARKS/ARGUMENT

Claims 1-29 are pending in this application. Claims 1-29 stand rejected. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1-29 are rejected under 35 U.S.C. § 103(a) over Applicant's admitted Prior art (the "AAPA") in light of U.S. Patent No. 5,172,051 (the "'051 patent").

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See MPEP § 706.02(j). Additionally, the Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention.

The Office Action has failed to show such a motivation in the cited references for combining the testing apparatus disclosed in the AAPA with the device shown in the '051 patent. M.P.E.P. §2143. Absent a showing of such a motivation, a prima facie case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicants request that the Examiner set forth a reference which shows such a

motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to combine such knowledge with the '051 patent so that Applicants have the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03

Simply because information is known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. *Id.* Inventions are frequently the process of combining prior art in a nonobvious manner. *Id.*

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See, Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining the AAPA, and the '051 patent is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would have rearranged the components in the AAPA to reflect the arrangement of components disclosed in Figure 4 of the '051 patent, "for the purpose of reducing in stray capacitance and increasing the probe bandwidth (COLUMN 4 LINE 49-51)." See Office Action, at 3. This assertion, however, is incorrect as it relates to the present invention. The statement relates to the overall probe tip assembly and reads:

The probe tip assembly 101 is designed to minimize stray tip capacitance by placing the tip resistor R_t as close as possible to the circuit being probed, while extending the resistor R_t as far as possible from the ground printed circuit trace of the tip RC subnetwork 240, thereby reducing stray capacitance due to plate effect capacitance between the resistor R_t and probe tip ground. The probe tip 102 is also located as far as practical from the probe tip assembly ground pin 250. Stray capacitance is further reduced by constructing the probe tip assembly housing 200 from non-conductive material, and avoiding the use of ground shielding in the probe tip assembly housing 200. This reduction in stray capacitance is a significant factor in increasing the probe bandwidth.

'051 Patent, col. 4, lns. 35-51.

The probe of the '051 patent is a different device than the tester that is the subject of the present invention. The probe of the '051 patent is a probe for an oscilloscope for testing outputs, while the tester of the present invention provides a signal to the inputs of devices under test. The '051 patent discloses the use of a resistor and capacitor in parallel with each other to reduce stray capacitance in the tip of the probe. These stray capacitances are inherent in the probe of the type disclosed in the '051 patent.

This is not a problem associated with the tester of the present invention. The problem solved by the present invention is delay in the input signal caused by the single series resistor of the prior art. (Page 10, lns. 1-12). Therefore, an entirely different problem is being solved by the present invention.

One seeking to solve the problem of the prior art as outlined in the specification would not look to the teaching of the '051 disclosure which is solving an entirely different problem for a different device.

The apparatus and method of the present invention provides a signal from a driver to multiple devices under test (DUTs) where the impedance of a resistor between the driver and the DUTs prevents a bad device from having an effect on other normal devices. Further, the capacitor in parallel with the resistor reduces the delay and distortion of the drive signal. Thus, the Office Action does not show or say how or why a person of ordinary skill in the art would be motivated to modify the arrangement of components of the AAPA in light of the '051 patent.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in the AAPA in light of the '051 patent. As a result, the Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1 through 29, and that the objection to those claims under §103 should be withdrawn.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

Application No.: 09/832,666

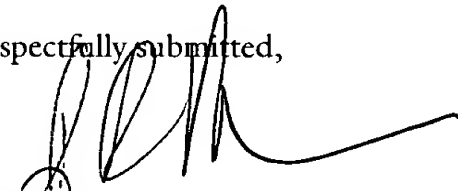
Docket No.: W1878.0169/P169

It is asserted that the present submission places the application in a form for allowance. Entry of this amendment is therefore earnestly solicited.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

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